

## REMARKS

Claims 1-19 continue to be the pending claims in the application.

Reconsideration of the application in light of the remarks which follow is respectfully requested.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ahluwalia (U.S. Patent No. 5,965,257) in view of Langer (U.S. Patent No. 4,600,634).

The Examiner contends that Ahluwalia discloses an article comprising a substrate having an ionic charge which is coated with a coating having essentially the same ionic charge, wherein the coating consists of a filler material and a binder material. The Examiner notes that the substrate is preferably fiberglass and the filler is selected from fly ash, charged calcium carbonate, and ceramic microspheres. The Examiner then contends that Ahluwalia teaches that it was well known to use clay as a filler material. The Examiner concedes that Ahluwalia does not teach that a metallic component is adhered to the coated substrate on one or both sides. The Examiner alleges that Langer discloses flexible fibrous endothermic sheet materials for fire protection wherein a backing comprising an aluminum foil is added to the backing of the sheet material to give an added degree of strength to the sheet material. The Examiner then contends that it would have been obvious to have used Langer's aluminum sheet to one or both sides of the coated substrate of Ahluwalia.

### **The Claimed Invention**

Claims 1-19 relate to a composite material comprising a substrate having an ionic charge, a coating which coats the substrate having essentially the same ionic charge, and a metallic component adhered to the coated substrate wherein said coating consists essentially of a filler material comprising clay and a binder material, wherein said binder material bonds

the filler material together and to the substrate and wherein said coating does not bleed through said substrate.

### **The Prior Art**

Ahluwalia teaches a structural article comprising a substrate having an ionic charge coated with a coating having essentially the same ionic charge wherein said coating consists essentially of a filler material and a binder material and wherein said binder material bonds the filler material together and to the substrate and wherein said coating does not bleed through said substrate. By coating the substrate with a coating having essentially the same ionic charge, a zero bleed through product may be produced without a need for a blowing step. *See* Ahluwalia col. 2, lines 3-6. The filler material taught by Ahluwalia is selected from the group consisting of fly ash, calcium carbonate, ceramic microspheres and mixtures thereof. *See* Ahluwalia col. 9, lines 58-60.

Langer teaches a non-intumescent, non-char forming, endothermic, essentially inorganic, flexible, fire-protective sheet material. The composition of the flexible sheet comprises an inorganic fiber, an organic polymer binder, and an inorganic endothermic filler wherein the weight ratio of organic to inorganic constituents is less than about 0.10 and wherein the weight ratio of the inorganic endothermic filler to the inorganic fiber is in the range of about 0.5 to 50. A backing, preferably aluminum foil, may be added to the sheet material. *See* Langer col. 4, lines 8-12.

### **There is No *Prima Facie* Case of Obviousness**

Ahluwalia and Langer do not support a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on the Applicants disclosure. *In re Vaeck*, 947 F2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

In this case, the combination of Ahluwalia and Langer does not teach or suggest all the claimed limitations. In the Office Action, the Examiner asserts that Ahluwalia discloses that it is well known to include clay as a filler material in structural articles in the building industry. Applicants note that the only mention in Ahluwalia of clay is in reference to a prior art reference in which it is taught that a filler and a binder can be used to make a coating together with various other costly constituents, such as thickening agents and viscosity modifiers. Many examples of binders and fillers are mentioned in the prior art, one such filler being clay. *See* Ahluwalia, col. 1, lines 12-33 and lines 42-53. Ahluwalia teaches a substrate having an ionic charge coated with a coating having essentially the same ionic charge wherein the coating consists essentially of a filler material and a binder material. Ahluwalia further teaches that the filler material is selected from the group consisting of fly ash, calcium carbonate, ceramic microspheres and mixtures thereof. Therefore, even though Ahluwalia mentions the use of clay as a filler in the prior art, Ahluwalia does not teach that clay can be used as a filler to prepare a coating having essentially the same ionic charge as the substrate it coats, wherein the coating will not bleed through the substrate when applied thereto. Langer does not remedy the deficiencies of Ahluwalia.

As noted above, in order for the Examiner to make out a *prima facie* case of obviousness, the combined references must teach or suggest all the claimed limitations. The combined teachings of Ahluwalia and Langer fail to teach all the claimed limitations.

Accordingly, Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. §103(a) as obvious over Ahluwalia in view of Langer.

**Conclusion**

In view of the foregoing remarks, Applicants submit that the present invention is now in condition for allowance. Accordingly, favorable reconsideration of the application is earnestly solicited. Please send any further correspondence relating to this application to the undersigned attorney at the address below.

Applicants believe no fee is due in connection with this communication. However, should any fee be due in connection with this communication, the Commissioner is authorized to charge any such fee to Deposit Account No. 06-1205.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,



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